

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SIEGFRIED HAMIAH

MAILED

OCT 26 2007

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Application No. 09/940,092

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on October 15, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On August 9, 2006, an Examiner's Answer was entered into the record. On page 4 of the Examiner's Answer cites "DE 19718423A1, by Gold" as prior art. The record, however, does not contain a full length English language translation of the Gold reference. Appropriate correction is required.

In addition, on September 18, 2007, Appellant filed a paper entitled “Amended Brief on Appeal”. A review of the file reveals that there is no indication that the Amended Brief on Appeal has been considered.

Lastly, On November 29, 2006, the examiner mailed a communication acknowledging receipt of Appellant’s Reply Brief reveals that the examiner did not proper acknowledgment. The comments made by the examiner would constitute a Supplemental Examiner’s Answer.

In accordance with MPEP 1207.05:

Every supplemental examiner’s answer must be approved by a Technology Center (TC) Director or designee. The examiner may furnish a supplemental examiner’s answer in response to any one of the following:

1. (A) A reply brief that raises new issues. The examiner may NOT include a new ground of rejection in the supplemental examiner’s answer responding to a reply brief. See 37 CFR 41.43(a)(2). Appellant may file another reply brief in response to the supplemental examiner’s answer within two months from the mailing of the supplemental answer. See MPEP § 1208.

2. (B) A remand by the Board for further consideration of a rejection under 37 CFR 41.50 (a). See MPEP § 1211.01. In response to a supplemental examiner’s answer that is written in response to a remand by the Board for further consideration of a rejection, appellant must either file: (1) a reply under 37 CFR 1.111 to request that prosecution be reopened; or (2) a reply brief to request that the appeal be maintained, within two months from

the mailing of the supplemental examiner's answer, to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding. Examiner may include a new ground of rejection in the supplemental examiner's answer responding to a remand by the Board for further consideration of a rejection. See MPEP § 1207.03.

3. (C) A remand by the Board for other purposes that are not for further consideration of a rejection under 37 CFR 41.50(a) . The examiner may NOT include a new ground of rejection in the supplemental examiner's answer responding to a remand by the Board, unless the remand is for further consideration of a rejection under 37 CFR 41.50(a) (see item B above). Appellant may file a reply brief with two months from the mailing of the supplemental answer.

A review of the Response to Reply Brief reveals that the examiner did not obtain proper approval.

Accordingly, it is

ORDERED that the application is returned to the Examiner for:

- 1) obtain a complete English language translation of Gold reference for the record;
- 2) consider the amended brief on appeal filed September 18, 2007;
- 3) vacate the Examiner's Answer mailed August 9, 2006, and issue a revised Examiner's Answer for the reasons set forth above.

4) proper acknowledgment of the Reply Brief is required and/or appropriate consideration of the Reply Brief dated October 8, 2006; and

5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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